

Serial No. 10/692,793

Attorney Docket No. 113708.129

REMARKS

On the initialed copy of the Form PTO-1449 filed on 30 January 2006, the examiner omitted initials next to one of the references. A mark-up copy of the Form PTO-1449 is attached for the examiner's reference. The examiner is requested to completely initial and return a copy of the Form PTO-1449 which was filed on 30 January 2006..

Claims 1-4, 6-10, 13-18 and 20-54 are pending. Claims 29-53 have been withdrawn. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1-4, 6-10, 13-18, 20-28 and 54 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,877,137, Rivette et al. ("Rivette '137") in view of U.S. Patent No. 6,389,434, Rivette et al. ("Rivette '434"). Independent claims 1, 18 and 25 have been amended to recite that "the annotation is image data or text, wherein each annotation can be different from every other annotation." Support for the amendment is located in the application as filed, for example page 28, lines 18-20, and FIG. 13. Insofar as the rejection may be applied to the claims as amended, the applicant respectfully requests that this rejection be withdrawn for the following reasons.

The applicant's prior discussions of Rivette '137, Rivette '434, and their deficiencies are expressly incorporated herein by reference.

Please note that the Advisory Action issued on March 27, 2007 did not address all of the applicant's arguments in the Amendment filed 13 March 2007. Although the Advisory Action included a detailed discussion, there are still arguments to which the examiner did not respond. Applicant's Request for Continued Examination indicates that the examiner should consider the

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arguments in the Amendment previously filed. The examiner is respectfully requested to respond to these arguments in the Amendment filed 13 March 2007:

- the argument referencing claim 3, pages 5-6 (claim differentiation);
- the argument referencing claims 18 and 25, pages 6-7 (principal of consistency);
- the argument referencing dependent claims 3-4, 7-10, 13, 15-16 and 23-24 (examiner's continued failure to address claim limitations, incorporating explicit arguments in Amendment filed 22 September 2006, pages 22-23); and
- the argument regarding independent claim 18 and dependent claim 7 (pages 7-8).

The examiner continues to contend that embedding a link in the document data is sufficient to meet the recited limitation. To the contrary, a document with a link to a note does not teach or suggest a "single logical document" with "the annotation embedded in the document data." (See independent claims 1, 18 and 25.) This is particularly true where "the annotation is image data or text." Clearly, a link in a document is not "image data or text."

Also, the examiner continues to contend that displaying a screen where notes are displayed in separate windows from the document (e.g., FIG. 6A, 6B), and where the note link buttons are displayed to the side of the relevant text, teaches "a single logical document having the annotation data embedded in the document data." Rivette '434's note link buttons are not "embedded in" the document data, even if "embedded" is given its broadest reasonable interpretation. To the contrary, the note link buttons are displayed away from the text.

Furthermore, Neither Rivette '434 nor Rivette '137 teaches or suggests that the each annotation that is embedded in the document data "can be different from every other annotation." Even if the examiner interprets Rivette '434's note link buttons as the recited annotation data, the

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user is limited to predetermined note link buttons which accordingly cannot be different from every other note link button.

Accordingly, the examiner has failed to make a prima facie case of obviousness with respect to independent claims 1, 18 and 25.

For at least these reasons, the combination of features recited in independent claims 1, 18 and 25, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Rivette '137 and Rivette '434 fail to show other recited elements as well, as discussed above.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from allowable independent claims 1, 18 and 25, but also because of additional features they recite in combination.

The applicant respectfully submits that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, the applicant has provided specific examples of elements in the claims that are clearly not present in the cited art.

In the Advisory Action, the examiner again applies the Microsoft OLE Programmers Reference, Volumes I and II, 1993, which he states "are herein incorporated by reference in their entirety." If the examiner applies a reference, as done here, the examiner must make the reference of record. The examiner cannot make a reference of record by attempting to incorporate by reference. Rather, "Copies of cited foreign patent documents and non-patent literature references (except as noted below) are automatically furnished without charge to applicant together with the Office action in which they are cited." MPEP 707.05(a). Further, the reference must be listed by the examiner on a Notice of References Cited document. The

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examiner has not provided any valid reason why the cited reference has not been provided to the applicant. Accordingly, any rejection relying on the Microsoft OLE Programmers Reference must be withdrawn, or the portion of the reference which is relied on must be supplied.

Also, the examiner appears to be relying on personal knowledge to support the finding of what is known in the art, i.e. that "the OLE standard is well known." The taking of Official Notice is respectfully traversed, and the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. MPEP 2144.03 Sec 37 CFR 1.104(d)(2). An examiner cannot simply reach conclusions based on their own understanding, or experience, or assessment of what would be basic knowledge or common sense. Rather, there must be some concrete evidence in the record in support of these findings. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Moreover, the examiner's expertise "may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697. Also, notice cannot be taken of facts constituting the state of the art. *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). It appears that the examiner is utilizing the noticed fact to provide a reason to modify Rivette, and to avoid providing a copy of a reference disclosing the allegedly well known finding; hence, the noticed fact is clearly not a peripheral issue. Accordingly, it is inappropriate for the examiner to rely on official notice, and the examiner must provide the above-mentioned affidavit or declaration. Therefore any rejection relying on the allegedly well-known Object Linking Embedded Standard or Microsoft OLE Programmers Reference must be withdrawn, or the portion of the reference which is relied on must be supplied.

The applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of

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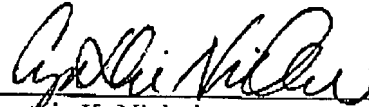
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simplicity, the applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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